

Application No. 09/769,939
May 3, 2004
Page 13 of 16

Docket No. PF01763NA - Calvert B. et al.

REMARKS

The issues outstanding in the instant application are as follows:

- Claims 1-19 and 22-42 were rejected under 35 U.S.C. 103(a) as being unpatentable over Ito et al. (US 6,289,279), in view of Mohi et al. (US 2003/0195008); and
- Claims 20-21 were rejected under 35 U.S.C. 103(a) as being unpatentable over Ito et al. (US 6,289,279) in view of Mohi et al. (US 2003/0195008), further in view of Lin (US 6,393,292).

Applicant appreciates the Examiner's thorough review of the present application and his easy-to-understand Office Action format, which bolds the claim numbers, recites the claimed element, and provides language from the reference that the Examiner feels is analogous to the claimed element. Nevertheless, Applicant traverses all the outstanding rejections and requests reconsideration and withdrawal thereof in light of the amendments and remarks contained herein.

Amendments to the Claims

Claims 1, 10, 21, 22, 25, 27, 29, 33, 35, 36, and 41 have been amended to clarify the language and more fully recite the invention. Essentially, the amendments clarify that a user input device is used to provide a more accurate geographic location. Support for these changes can be found throughout the originally-filed specification including: page 6 lines 3-9, page 6 lines 20-24, page 17 line 2 through page 18 line 2, page 18 line 24 through page 19 line 2, and page 27 line 32-37.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment was made for the purpose of narrowing

Application No. 09/769,939
May 3, 2004
Page 14 of 16

Docket No. PF01763NA – Calvert B. et al.

the scope of any claim, unless Applicant had argued herein that such amendment was made to distinguish over a particular reference or combination of references.

Interview Summary

Applicant thanks the Examiner for his courtesy in extending a telephone interview with Applicant's representative on April 29, 2004. The Examiner and Applicant's representative discussed Mohi et al. (US 2003/0195008), which is a continuation-in-part of application no. 09/899,612 filed on July 5, 2001 and also related to provisional application no. 60/218,454 filed July 14, 2000. Applicant understands that the Examiner will seek to provide a reference that directly qualifies as prior art in order to overcome the priority date deficiency of Mohi 2003.

Information Disclosure Statement

Filed herewith is an Information Disclosure Statement and Form SB/08 listing one reference. In light of the Examiner's Interview summarized above, Applicant found Mohi (US 2002/0008600), which is the publication of application no. 09/899,612 filed on July 5, 2001 related to Mohi 2003.

35 U.S.C. § 103(a) - Ito in view of Mohi

Claims 1-19 and 22-42 were rejected under 35 U.S.C. 103(a) as being unpatentable over Ito et al. (US 6,289,279), in view of Mohi et al. (US 2003/0195008). Mohi 2003 was filed at the U.S. Patent and Trademark Office on April 23, 2003, which is after the filing date of the present application (January 26, 2001). Thus, Mohi 2003 is not eligible as a prior art reference under 35 U.S.C. § 102 or 103. Applicant notes that Mohi 2003 is a continuation-in-part of Mohi (US 2002/0006800) filed July 5, 2001. Mohi 2002 is a non-provisional application of provisional application no. 60/218,454 filed on July 14, 2000.

Application No. 09/769,939
May 3, 2004
Page 15 of 16

Docket No. PF01763NA - Calvert B. et al.

The portions of Mohi 2003 referenced in the Office Action are not contained in Mohi 2002, and thus are not entitled to the earlier reference date of July 14, 2000. Because the Examiner has not produced a *prima facie* case of obviousness (see MPEP § 2142), reconsideration and withdrawal of the rejection of claims 1-19 and 22-42 under 35 U.S.C. § 103(a) as being unpatentable in view of Ito and Mohi is respectfully requested.

35 U.S.C. § 103(a) - Ito and Mohi in view of Lin

Claims 20-21 were rejected under 35 U.S.C. 103(a) as being unpatentable over Ito et al. (US 6,289,279) in view of Mohi et al. (US 2003/0195008), further in view of Lin (US 6,393,292). Mohi was filed at the U.S. Patent and Trademark Office on April 23, 2003, which is after the filing date of the present application (January 26, 2001). Thus, Mohi is not eligible as a prior art reference under 35 U.S.C. §§ 102 or 103. Applicant notes that Mohi 2003 is a continuation-in-part of Mohi (US 2002/0006800) filed July 5, 2001. Mohi 2002 is a non-provisional application of provisional application no. 60/218,454 filed on July 14, 2000.

The portions of Mohi 2003 referenced in the Office Action are not contained in Mohi 2002, and thus are not entitled to the earlier reference date of July 14, 2000. Because the Examiner has not produced a *prima facie* case of obviousness (see MPEP § 2142), reconsideration and withdrawal of the rejection of claims 20-21 under 35 U.S.C. § 103(a) as being unpatentable in view of Ito, Mohi, and Lin is respectfully requested.

SUMMARY

The application is in condition for allowance and a favorable response at an early date is earnestly solicited. Should the Examiner have any questions, comments, or suggestions, the Examiner is invited to contact Applicant's representative at the telephone number indicated below.

Application No. 09/769,939
May 3, 2004
Page 16 of 16

Docket No. PF01763NA – Calvert B. et al.

Please charge any fees associated herewith, including extension of time fees, to
Deposit Account 502117.

Respectfully submitted,

Please send correspondence to:
Motorola, Inc.
Intellectual Property Dept. (SYC)
600 North U.S. Highway 45, AS437
Libertyville, IL 60048
Customer Number: 20280

By: Sylvia Chen 03 MAY 2004
Sylvia Chen Date
Attorney for Applicant
Registration No. 39,633
Tel. No. (847) 523-1096
Fax No. (847) 523-2350
Email: Sylvia.Chen@motorola.com